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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,910	07/31/2003	Hiroyuki Yanagisawa	KON-1807	9630

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EXAMINER	
CHEA, THORL	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/631,910	YANAGISAWA, HIROYUKI
	Examiner	Art Unit
	Thorl Chea	1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Specification

1. The amendment filed August 20, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The changing the number in the Drawing FIG-2 and F-3 from "No.1 to No. 16" to "No.1 to No. 15" raises the issue of new matter. First, the present application fails to incorporate by reference the priority document stated in the remark. Second, line represent by sample No. 8 appears not to be corresponding to the value set forth as (u*, v*) in Table 2. Third, there is confusion between the number and the line presented in the drawing, since the number shifts form 1-16 to 1-15.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 1278101 (EP'101). See pages 70-83, claims 1-27, which discloses a photothermographic material as claimed. The value of (L, u*, v*) in the CIELAB system presented in the claimed is related to the properties of the material after the image forming process, and is considered as inherent to the material of EP'101 because of the similarity of the composition of the claimed material and that of the EP'101. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art at the time the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nishijima et al (US Patent No. 6,699,649). See columns 94-98 claims 1-24, which discloses a photothermographic material as claimed. The value of (L, u*, v*) in the CIELAB system presented in the claimed is related to the properties of the material after the image forming process, and is considered as inherent to the material of the '649 patent because of the similarity of the composition of the claimed material and that of the '649 patent. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art at the time the invention was made.

6. Claims 1-12, 18-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Oya et al (US Patent No. 6,376,166). See columns 97-102 claims 1-18, which discloses a photothermographic material as claimed. The value of (L, u*, v*) in the CIELAB system presented in the claimed is related to the properties of the material after the image forming process, and is considered as inherent to the material of the '166 patent because of the similarity of the composition of the claimed material and that of the '166 patent. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art at the time the invention was made

7. Claims 1-12, 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Van Ackere (US Patent No. 6,284,442), or Iwasaki et al (US Patent No. 6,268,118). See '442 patent in columns 24 claim 7; and the '118 patent in column 28-30, claims 1-21. The '442 patent, and '118 patent disclose a photothermographic material as claimed. The value of (L, u*, v*) in the CIELAB system presented in the claimed is related to the properties of the material after the image forming process, and is considered as inherent to the material of the ''442, and '118 patents because of the similarity of the composition of the material . In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art at the time the invention was made.

8. Claims 1-13, 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshioka et al (US Patent No. 6,413,712).

See column 51-12 claims 1-14 wherein the material contains a phenol compound of formula (II) within the scope of formula of claim 13 of the present invention. The '712 patent discloses a photothermographic material as claimed. The value of (L, u*, v*) in the CIELAB system presented in the claimed is related to the properties of the material after the image forming process, and is considered as inherent to the material of the '712 patent because of the similarity of the composition of the material . In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art at the time the invention was made

9. Claim 13-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Oya et al (US Patent No.6,376,166).

The Oya discloses photothermographic material having a reducing agent within the scope of the claimed invention. See compound of formula (I) in the abstract and the definition of V^9 in column 7, lines 55-60 which an aryl group such as phenyl, p-methylphenyl and naphthyl. See also the hydrazine compound and nucleating agent in columns 55-64. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the reducing agent within the scope of Oya's suggestion, and thereby provide a material as claimed.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,699,649. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the material contains same reducing agent. See the reducing agent in claims 1-2 of the '649 vs. claims 13-15 of the present claimed invention.

Conclusion

12. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea tlw
September 24, 2004

Thorl Chea
Primary Examiner
Art Unit 1752